

REMARKS

I. Status of the Claims

Claims 1-108 are pending in this application. No claim has been amended in this Reply. Applicants acknowledge and appreciate that the rejection of claims 1, 23, 27, 96, 101, 105, 106, and 108 under 35 U.S.C. § 112, second paragraph, has been withdrawn. (Office Action dated December 13, 2001, page 2, line 16.)

Applicants further acknowledge and appreciate that the rejection of claims 34-37 and the provisional rejection of claims 1-14 and 41-104 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-83 of copending Application No. 09/692,360, claims 1-95 of copending Application No. 09/692,155, and claims 1-16 and 37-104 of copending Application No. 09/692,716 were also withdrawn in the final Office Action dated December 13, 2001. "In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated." M.P.E.P. § 706.07. Because these double patenting rejections were not expressly maintained in the instant Office Action, Applicants understand that these rejections were withdrawn by the Examiner.

II. Rejection Under 35 U.S.C. § 112, Second Paragraph

The rejection of claim 12 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention has been maintained in the instant Office Action. (Office Action dated

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December 13, 2001, page 2, lines 4-15.) Applicants respectfully traverse this rejection for at least the reasons of record and the additional reasons detailed below.

Specifically, the Examiner alleges that the definition provided by the specification for the term *essentially non-crosslinked* "is circular and still lacks the standard to determine how much crosslinking on the copolymer is considered as must occur to be considered as a non-crosslinked copolymer." (Office Action dated December 13, 2001, page 2, lines 12-14.) Even assuming, *arguendo*, that the specification lacks a standard, the Examiner must assess whether one skilled in the art would be reasonably apprised of the scope of the invention. M.P.E.P. § 2173.05 (b) (emphasis supplied). And this assessment must not be analyzed in a vacuum, but, rather, in light of, among other things, the claim interpretation that one of ordinary skill in the art at the time the invention was made would give. M.P.E.P. § 2173.02. In view of the very well-known meaning of a crosslinked polymer, one of ordinary skill in the art would clearly know what is encompassed by the phrase "*essentially non-crosslinked*," especially in view of the specification. It is clear from a plain reading of the specification, for example, that there are crosslinked copolymers and there are non-crosslinked copolymers, which include "*essentially non-crosslinked copolymers*." The specification provides that "*essentially non-crosslinked copolymers*" are copolymers that may have some crosslinking, but not enough to consider them "*crosslinked copolymers*." (Specification, page 5, lines 5-7.) While the Examiner does not have to read limitations from the specification into the claims, she certainly has to interpret the claims in view of the specification. Applicants respectfully submit that this definition, although it is not as precise as the Examiner would prefer, more than reasonably apprises one of ordinary

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skill in the art of what is meant by the term "essentially non-crosslinked copolymer." Thus, as Applicants have satisfied the statutory requirement of reasonably apprising those skilled in the art of what is claimed, Applicants respectfully request that this rejection be withdrawn.

III. Rejections Under 35 U.S.C. § 103(a)

The Examiner has maintained the rejections, under 35 U.S.C. § 103(a), of the following:

- (A) claims 1-31, 38-40, and 94-108 over European Patent No. EP 0874017 A2 to *Dalle et al.* ("Dalle") in view of U.S. Patent No. 5,650,383 to *Dubief et al.* ("Dubief"),
- (B) claim 32 over the *Dalle/Dubief* combination in further view of U.S. Patent No. 5,063,051 to *Grollier et al.* ("Grollier"),
- (C) claim 33 over the *Dalle/Dubief/Grollier* combination in further view of U.S. Patent No. 4,957,732 to *Grollier et al.* ("Grollier '732"),
- (D) claims 34-37 over the *Dalle/Dubief/Grollier/Grollier '732* combination in further view of U.S. Patent No. 6,011,126 to *Dubief et al.* ("Dubief '126"),
- (E) claims 41-67 over the *Dalle/Dubief/Grollier/Grollier '732/Dubief '126* combination in further view of U.S. Patent No. 6,039,936 to *Restle et al.* ("Restle"), and
- (F) claims 68-93 over the *Dalle/Dubief/Grollier/Grollier '732/Dubief '126/Restle* combination in further view of U.S. Patent No. 5,948,739 to *Inman* ("Inman").

Applicants continue to traverse these rejections for at least the reasons of record and the additional reasons set forth below.

To establish a *prima facie* case of obviousness, the Examiner bears the burden of establishing at least that there exists some suggestion or motivation to modify or combine reference teachings. M.P.E.P. § 2143. This showing must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Importantly, the Examiner must present a "full and reasoned explanation" of her decision, wherein the reasons supporting the decision are articulated and the decision is sound. *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). In the present case, the Examiner has failed to articulate a reason why one of skill in the art would be motivated to modify *Dalle* by adding the silicones of *Dubief*.

With respect to the *Dalle/Dubief* combination, upon which every rejection is primarily based, the Examiner contends without pointing to any specific teaching in either of the references at all, let alone citing any "clear and particular" evidence, that "a skilled worker would have expected to successfully obtain a hair [product] which retains the effects of the silicone softeners from the modification." (Office Action dated December 13, 2001, page 4, lines 10-12.) *Dubief*'s compositions themselves, however, leave hair "particularly easy to disentangle, soft and light ... well-behaved ... easy to style and [with] more body." (*Dubief*, col. 1, lines 39-43.) Thus, under the Examiner's reasoning, modifying any composition by adding the silicones of *Dubief* for the purposes taught by *Dubief* would be obvious. This reasoning does not support an obviousness rejection, rather, the Examiner must show more.

Specifically, the Examiner must show why one of skill in the art would have selected *Dalle* for modification in the first place. "[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would

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have selected these components for combination in the manner claimed." *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (emphasis supplied). Further, "the agency [here, the Examiner] must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made.'" *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002) (citations omitted). Here, the Examiner, in a failed attempt based on commonsense-type reasoning, has not articulated the requisite satisfactory explanation.

Only in hindsight could it have been obvious to one with the cited references before him to have combined their teachings. In fairness, it might have been possible for one to attempt the combination proposed by the Examiner, but "obvious to try" is not the standard" for obviousness under § 103. *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1374, 56 U.S.P.Q.2d 1065, 1075 (Fed. Cir. 2000).

As the Examiner has failed to satisfy her burden under 35 U.S.C. § 103, with respect to the primary combination of references, i.e., *Dalle/Dubief*, Applicants respectfully submit that this combination and all other combinations with secondary references relying on *Dalle/Dubief* are improper. Accordingly, Applicants respectfully request withdrawal of all § 103 rejections.

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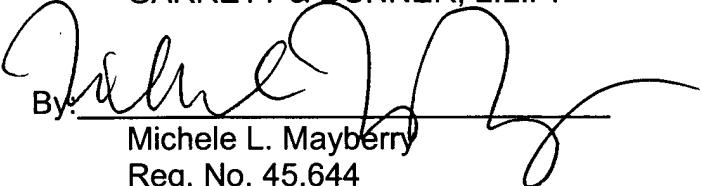
IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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